

REMARKS

Claims 1-19 are pending in the application. Claims 13 and 19 are amended herein. New claim 20 is added by this amendment.

The examiner has objected to the drawings as failing to comply with 37 C.F.R. § 1.84(p)(5) because the examiner contends that the feature corresponding to reference numeral 31 has not been described. However, the examiner appears to have overlooked the first sentence of the paragraph beginning on page 11, line 15 (which published as paragraph [0066] in U.S. Patent Application Publication No. 2006/0011437 A1) which states "[a]s shown in Fig. 9, the cover strip is formed by an generally compressed S cross-sectioned plastics material strip 31" Because reference numeral 31 appears in the captioned application, no drawing amendment or amendment to the specification is required. Accordingly, withdrawal of this objection is respectfully requested.

The examiner, citing 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(o), objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. The examiner admits that the drawings show the claimed subject matter, but then contends, on page 3, item 2 of the May 9, Office Action, that "there doesn't appear to be any proper description for the main outer surface of the lid portion being convex and the main outer surface of the base being concave." The examiner appears to be ignoring the fact that, "under proper circumstances, drawings alone may provide a 'written description' of an invention as required by § 112." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991). While it is believed that the drawings of the captioned application support the claim language "the lid portion being shaped so as to have a convex main outer surface and the base portion being shaped so as to have a concave main outer surface," this language has been added to the paragraph beginning at page 9, line 14 (which published as paragraph [0056] in U.S. Patent Application Publication No. 2006/0011437 A1) in an effort to advance prosecution of the application. As the examiner has already noted, support for this Amendment to the Specification is found in the drawings. Accordingly, withdrawal of the objection to the specification is respectfully requested.

The examiner rejected claim 19 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the examiner pointed out that there is insufficient antecedent basis for the term "the wheels/rolls" in claim 19. Claim 19 has been amended to depend from claim 18, instead of claim 13, to cure the antecedent basis error noted by the examiner. Accordingly, withdrawal of the indefiniteness rejection of claim 19 is respectfully requested.

The examiner rejected claims 1-3 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 3,865,166 to Pedro in view of either U.S. Pat. No. D443,136 to Fusi or U.S. Pat. App. Pub. No. 2004/0031654 to Chang. It is a fundamental tenet of patent law that a prima facie case of obviousness cannot be established in the absence of some teaching, motivation, or suggestion supporting the modification or combination of the references relied upon in making the rejection. The well-established rule of law for a finding of obviousness under 35 U.S.C. § 103(a) has been emphasized by the Court of Appeals for the Federal Circuit as follows, "[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." *In re Lee*, 277 F.3d 1338 at 1343, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In an apparent attempt to establish a prima facie case of obviousness in the present case, the Examiner makes a single, conclusory statement on page 4, item 4 of the May 9, 2006 Office Action that "[t]o have merely provided the case of Pedro with a design in which the main outer

surface of the lid is convex while the main outer surface of the base is concave would have been obvious in view of either Fusi as shown in Figures 5 and 6 or Chang as shown in Figures 1 and 3." The examiner's explanation of the rejection is insufficient for a number of reasons. Firstly, for a teaching, motivation, or suggestion to be proper, it must be suggested by the prior art references, or else the examiner must present a convincing line of reasoning as to why the invention is obvious. In the present rejection, the Examiner's single, conclusory sentence hardly constitutes a convincing line of reasoning as to why the invention defined by claims 1-3 and 13 is obvious, but yet the examiner has not identified where the prior art identifies, expressly or impliedly, the purported teaching, motivation, or suggestion for supporting the combination of Pedro with Fusi or Chang. Instead, the examiner simply calls out the Figures of Chang and Fusi that show the feature of claims 1-3 and 13 that is missing from Pedro. Furthermore, while Fusi and Chang each appear to teach a base portion with a concave surface, the concave surfaces of Fusi and Chang curve along the length of the respective cases. Therefore, it is not reasonable to believe that a designer of a slender, elongate weapons case, such as the one shown in Pedro which is clearly intended to carry a rifle, would be motivated to have a concave surface that curves along the length of the case in the manner that is shown in either Fusi or Chang. Combining the teachings of Fusi or Chang with Pedro would result in a weapons case into which a rifle would most assuredly not fit. It should be noted that Pedro has no discussion about the shape of sections 12 and 13 which comprise Pedro's gun case. A person skilled in the art reading Pedro, which says nothing about the shape of sections 12 and 13, would not be motivated to change the shape of these sections at all, let alone in the particular way recited in Applicant's claims 1-3 and 13. The emphasis in Pedro is the flexible fastening means and pliable hinge, not the shape of the sections of the weapons case. The examiner appears to have engaged in impermissible hindsight reconstruction by using Applicant's claims as a blue print to select the cited prior art references.

Simply stated, there is no motivation to combine Pedro with either Fusi or Chang and, in fact, modifying Pedro in accordance with Fusi and Chang results in the creation of a weapons case that is not usable for its intended purpose. Therefore, the examiner has not established a prima facie case of obviousness to support the rejection of claims 1-3 and 13. The amendments to claim 13 are made to conform its language more closely to that of method claim 1 in order to

reduce the number of issues that may be present in connection with any appeal that may be taken in the present application. In addition, independent claims 2 and 3 have been amended to recite "the zip fastener arrangement having an expandability feature to permit volume expansion of the suitcase." Such a zip fastener arrangement having an expandability feature is not present in Pedro, Fusi, or Chang.

As further evidence to establish the non-obviousness of Applicant's claimed invention recited in claims 2 and 3 (as well as certain dependent claims that depend from independent claims 1 and 13), a Declaration Under 37 C.F.R. 1.132 is submitted concurrently herewith to discuss two secondary factors, namely, "commercial success" and "copying by others," that are evidence of the non-obviousness of Applicant's claimed invention. While it is believed that the discussion above regarding the lack of motivation to combine Pedro with either Fusi or Chang is sufficient to overcome the obviousness rejection, the accompanying Rule 132 Declaration is being submitted at this time (i.e., before a final Office Action) so that it will be considered "timely" filed for consideration by the examiner, and if necessary, the Board of Patent Appeals and Interferences, without having to make the extra showings that are necessary for submission of such declarations after a final Office Action. See M.P.E.P. § 716.01, which is reproduced as follows:

The following criteria are applicable to all evidence traversing rejections submitted by applicants, including affidavits or declarations submitted under 37 CFR 1.132:

(A) Timeliness. Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. *In re Rothermel*, 276 F.2d 393, 125 USPQ 328 (CCPA 1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

- (1) prior to a final rejection,
- (2) before appeal in an application not having a final rejection, *
- (3) after final rejection **>, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e); or

(4) after the prosecution is closed (e.g., after a final rejection, after appeal, or after allowance) if applicant files the affidavit or other evidence with a request for continued examination (RCE) under 37 CFR 1.114 in a utility or plant application filed on or after June 8, 1995; or a continued prosecution application (CPA) under 37 CFR 1.53(d) in a design application.

For affidavits or declarations under 37 CFR 1.132 filed after appeal, see 37 CFR 41.33(d) and MPEP § 1206 and § 1211.03.<

(B) Consideration of evidence. Evidence traversing rejections, when timely presented, must be considered by the examiner whenever present. All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action. The extent of the commentary depends on the action taken by the examiner. Where an examiner holds that the evidence is sufficient to overcome the prima facie case, the comments should be consistent with the guidelines for statements of reasons for allowance. See MPEP § 1302.14. Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as "the declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims" without an explanation supporting such findings are insufficient.

(Emphasis added)

As discussed in the Declaration Under 37 C.F.R. 1.132, the owner of the present application is believed to be the first company to ever have developed a plastic molded hard suitcase with an expandable zip fastener. As further discussed in the accompanying Declaration Under 37 C.F.R. 1.132, after introducing such a piece of luggage into the marketplace, it became a resounding success and has been copied essentially identically by two competitors. Based on the foregoing remarks and the accompanying Declaration Under 37 C.F.R. 1.132, it is submitted that claims 1-3 and 13, as well as claims 4-12 which depend direction or indirectly from claim 1 and claims 14-20 which depend directly or indirectly from claim 13, are in condition for allowance and such action is respectfully requested.

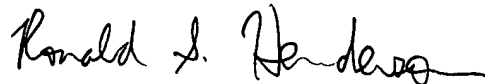
Because claims 1-3 and 13 are in condition for allowance as explained above, the obviousness rejections under 35 U.S.C. § 103(a) of claims 4-12 and 14-19 are rendered moot.

New claim 20 depends from claim 13. Accordingly, the application is believed to be in condition for allowance and such action is respectfully requested.

In the event that there are any questions related to this amendment or to the application in general, the Examiner is invited to call the undersigned at (317) 231-7341 to discuss any outstanding issues or concerns so that allowance of the present application may be expedited. It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and that shortages in fees, if any, be charged to the Account of Barnes & Thornburg, Deposit Account No. 10-0435, with reference to our file 3856-77784.

Respectfully submitted,

BARNES & THORNBURG LLP

A handwritten signature in black ink, appearing to read "Ronald S. Henderson", with a stylized flourish at the end.

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